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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEREMY G. DUNNE and DAVID WILLIAMS

Appeal 2010-001889
Application 10/801,425
Technology Center 3700

Before STEVEN D.A. McCARTHY, FRED A. SILVERBERG and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from a final rejection of claims 1-12, 23, 24 and 26-31. The real party in interest is Laser Technology, Inc. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The Claimed Subject Matter

This invention pertains to a golfing rangefinder that determines distance via a laser and displays an output based on this distance to suggest a golf club type determined by user input of at least one representative range for at least one golf club type. Independent claim 23 is illustrative of the invention and is reproduced below:

23. A method associated with a golf game comprising:
- entering at least one club type and associated representative user range for said at least one club type to a data store associated with a rangefinding instrument;
 - storing in said data store said at least one club type and associated representative user range;
 - determining a range to a selected point on a golf course with said rangefinding instrument using a laser rangefinder;
 - determining an inclination to said selected point on said golf course with a tilt sensor in said rangefinding instrument;
 - determining a wind speed and direction with a wind speed sensor and directional sensor in said range finding instrument;
 - entering other factors in the rangefinding instrument, wherein the other factors include at least one of a golf ball type, altitude, and barometric pressure;
 - extrapolating a suggested club type appropriate to said determined range from said at least one club type, associated representative user range, inclination, wind speed and direction, and other factors; and
 - displaying said suggested club type to a user of said rangefinding instrument.

References Relied on by the Examiner

| | | |
|------------------|--------------|---------------|
| Jones | US 4,136,394 | Jan. 23, 1979 |
| Mauritz | US 5,283,732 | Feb. 1, 1994 |
| Jenkins | US 5,294,110 | Mar. 15, 1994 |
| Wilens | US 5,779,566 | Jul. 14, 1998 |
| Hines | US 5,933,224 | Aug. 3, 1999 |
| Zeiner-Gundersen | US 6,059,672 | May 9, 2000 |

The Rejections on Appeal

1. Claims 23, 29 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Wilens and Hines (Ans. 3).
2. Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Wilens, Hines and Mauritz (Ans. 7).
3. Claims 1-7, 10, 12, 26 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Mauritz and Hines (Ans. 11).
4. Claims 8, 9 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Mauritz, Hines and Jenkins or Jones (Ans. 15).
5. Claims 27 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Mauritz, Hines and Wilens (Ans. 17).

ISSUE

Does Zeiner-Gundersen suggest a laser rangefinder and is the combination of Zeiner-Gundersen and Hines unsatisfactory for its intended purpose, a change in the principle operation of Zeiner-Gundersen or a result of improper hindsight?

ANALYSIS

Appellants argue claims 23, 29 and 31 as a group. Appellants further argue claims 1-7, 10, 12, 26 and 30 as a group, claims 9 and 11 as a group, and claims 27 and 28 as a group. We exercise our discretion and select a single claim from each group to decide the appeal with respect to that group (37 C.F.R. § 41.37(c)(1)(vii)). Appellants also argue claim 24 and claim 8 separately, each of which will be addressed.

Claims 23, 29 and 31 in view of Zeiner-Gundersen, Wilens and Hines

We select independent claim 23 for review. Claim 23 requires “a laser rangefinder.” Appellants contend that “Zeiner-Gundersen simply does not disclose a laser rangefinder” (App. Br. 6, *see also* Reply Br. 5).

Appellants’ basis is that Zeiner-Gundersen’s retroflective laser scanner “is configured to determine the curvature of [a] green surface” and that Zeiner-Gundersen “shows using geometry to determine a range, rather than a laser rangefinder as required” (App. Br. 7; *see also* Reply Br. 5). Contrary to Appellants’ contention, Zeiner-Gundersen discloses “a distance measuring laser” and “laser distance measuring means” (Zeiner-Gundersen 2:31-32, 3:12-13 and 4:27). More specifically, Zeiner-Gundersen states “[f]or short distances the laser may be used to obtain the distance” (Zeiner-Gundersen 6:43-44). The Examiner also cites to these passages in Zeiner-Gundersen (Ans. 3-4). Accordingly, Appellants’ contention is not persuasive.

Appellants further contend that “combining Hines with Zeiner-Gundersen renders Zeiner-Gundersen unsatisfactory for its intended purpose; therefore, the rejection is improper” (App. Br. 7, *see also* Reply Br. 6-7). Appellants’ basis is that Hines discloses a laser rangefinder that is

used “to only determine the reflective distance between two points on the golf course” and “[t]here is simply no teaching in Hines of a high performance retroflective laser scanner to scan an area between the ball and the cup in order for the microprocessor to determine the curvature of the green” (App. Br. 8). Appellants also contend that “the combination of Hines with Zeiner-Gundersen changes the principle of operation of Zeiner-Gundersen” (App. Br. 9; *see also* Reply Br. 7-8). Appellants’ basis for this latter contention is that “substituting the laser rangefinder of Hines destroys the principle [of] operation of Zeiner-Gundersen as it does not perform the required determination of a curvature of the green” (App. Br. 9). Both contentions are premised on the substitution of Hines’ laser rangefinder in place of Zeiner-Gundersen’s retroflective laser scanner (App. Br. 8, 9).

Zeiner-Gundersen discloses *two* rangefinding methods, one employing a retroflective laser for the short game and another “based on simple geometry which utilizes the height of the flag” for the long game (Appellants and the Examiner both refer to this latter method as ‘mil radian’) (Zeiner-Gundersen 5:19-25). Appellants’ substitution of Hines’ laser for Zeiner-Gundersen’s retroflective laser is not the substitution stated by the Examiner who, instead, substitutes Hines’ laser rangefinder for Zeiner-Gundersen’s *mil radian component* (*see* Ans. 6, “it would have been obvious to an artisan to substitute one method (laser rangefinder) for the other (mil radian)”). Consequently, the combination Appellants address is not the combination cited by the Examiner¹. Further, the Examiner states that the

¹ Appellants’ combination results in Hines’ rangefinder combined with Zeiner-Gundersen’s long game system whereas the Examiner’s combination results in Hines’ rangefinder combined with Zeiner-Gundersen’s short game system.

suggestion for using Hines' laser rangefinder in place of Zeiner-Gundersen's mil-radian process "is implicit in the accuracy of the technology, i.e. improved accuracy of distance to target reading," an accuracy acknowledged by Appellants (Ans. 6-7 *citing* Appellants' acknowledgement). "[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007). Claim 23 is directed to features already known in the prior art (i.e., Zeiner-Gundersen's device employing a mil radian process) that is altered by the substitution of one element for another known in the field (substituting Hines' known laser rangefinder for Zeiner-Gundersen's mil radian process) such that the combination yields a predictable result (i.e., greater accuracy). Accordingly, Appellants' contention is not persuasive².

Appellants further contend that the Examiner applied a New Ground of Rejection in asserting the substitution of Hines' laser rangefinder for Zeiner-Gundersen's mil radian process (Reply Br. 8 and 9). Appellants' basis is that "throughout the prosecution the Examiner has relied upon Hines for teaching a laser rangefinder by substituting the laser rangefinder of Hines for the retroflective laser scanner of Zeiner-Gundersen" (Reply Br. 8). Appellants conclude that "the Examiner now appears to assert another alternative holding allegedly substituting the laser rangefinder of Hines for only the simple geometry algorithm of Zeiner-Gundersen" (i.e. the mil radian algorithm)(Reply Br. 9).

² Appellants also contend that Zeiner-Gundersen teaches away from Hines (App. Br. 9; Reply Br. 10) but it is not persuasive for similar reasons.

The failure of an Examiner to designate a New Ground of Rejection is a matter reviewable by petition under 37 C.F.R. § 1.181(a) (*see* Manual of Patent Examining Procedure (MPEP) §1207.03 IV) and are thus not within the jurisdiction of the Board. *See In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (citing *In re Hengehold*, 440 F.2d 1395, 1403-04 (CCPA 1971) (stating that there are many kinds of decisions made by examiners, “which have not been and not now appealable to the Board or this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner.”)); *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967) (holding that the refusal of an examiner to enter an amendment of claims is reviewable by petition under 37 C.F.R. § 1.181, and not by appeal to the Board).

Thus, we will address only the merits of the contention, not its designation. Accordingly to the record before us, paragraphs 3 and 4 in the Final Rejection mailed Mar. 21, 2008, both state “[t]he improvement for use of laser rangefinder over mil-radian process is implicit in the accuracy of the technology.” Appellants subsequently state, when addressing Hines, that “A laser rangefinder is inherently more accurate than an optical mil-radian approach” (Amendment After Final mailed May 21, 2008, p. 6). *See also* the Advisory Action mailed Jun 5, 2008, paragraph 13 and the Final Rejection mailed Nov. 7, 2008, paragraphs 3 and 5 for additional discussions by the Examiner regarding the desirable use of a laser rangefinder over Zeiner-Gundersen’s mil radian process. Consequently, and contrary to Appellants’ contention, we are not persuaded that throughout prosecution

the Examiner failed to indicate which of Zeiner-Gundersen's measuring systems was being compared to and replaced by Hines' laser rangefinder.

Appellants further assert that the Examiner relied upon improper hindsight reasoning because the "articulated rationale is unsupported in Hines" (App. Br. 10; *see also* Reply Br. 10-11). We disagree because the Examiner's articulated reason for combining (i.e. substitution) Hines and Zeiner-Gundersen is due to Hines' laser rangefinder *being more accurate* than Zeiner-Gundersen's mil radian method, an undisputed statement admitted by Appellants (Ans. 6-7 *citing* Appellants' Amendment After Final, p. 6, mailed May 21, 2008). Accordingly, Appellants' contention is not persuasive.

Based on the record presented, we sustain the Examiner's rejection of claim 23, and non-argued dependent claims 29 and 31, as being unpatentable under 35 U.S.C. § 103(a) over Zeiner-Gundersen, Wilens and Hines.

Claim 24 in view of Zeiner-Gundersen, Wilens, Hines and Mauritz

Claim 24 depends on claim 23 and further requires "computing at least said suggested club type and an associated representative user range for said at least one other club type for retention in said data store." Appellants contend that "[t]he Office fails to provide a factual basis either expressly or inherently in Wilens, Mauritz, and Hines for establishing these features" (App. Br. 11). Mauritz teaches a computing device "for computing a best golf club number for a player" from a "data table" that stores "player personal data" (Mauritz 47-58 and Fig. 4). The Examiner refers to this citation and states "[t]he Office maintains that Mauritz determination for suggesting a particular club type for a range based on personal data is

performing same computing function claimed by Appellant” (Ans. 8-9). Appellants do not address this finding by the Examiner. Accordingly, Appellants’ contention that the Examiner has failed to provide a factual basis for these features is not persuasive in light of the Examiner’s reference to Mauritz *supra*. The Examiner’s rejection of claim 24 over Zeiner-Gundersen, Wilens, Hines and Mauritz is sustained.

Claims 1-7, 10, 12, 26 and 30 in view of Zeiner-Gundersen, Mauritz and Hines

We select independent claim 1 for review. Claim 1 also requires “a laser rangefinder” as does claim 23 above. Appellants contend that the applied art of record fails to teach or suggest this feature “for similar reasons as discussed above with respect to independent claim 23” (App. Br. 11). Appellants present no other arguments. Accordingly, as the Examiner’s rejection of claim 23 was sustained above, for similar reasons the Examiner’s rejection of claim 1, and claims 2-7, 10, 12, 26 and 30, are likewise sustained.

Claim 8 in view of Zeiner-Gundersen, Mauritz, Hines and Jenkins or Jones

Claim 8 depends from claim 1 and further requires user inputted “wind speed and direction” for club type suggestion. Appellants contend that the Examiner’s reliance upon Jenkins or Jones (both of which teach manual input of wind speed and direction) is “improper for failure to comply with 35 U.S.C. § 132 due to lack of sufficient detail” (App. Br. 12; Jenkins 2:39-41; Jones Fig 1, *see also* 3:57-61). Appellants also contend the rejection is improper because the Examiner “has provided no evidence why the skilled artisan would modify the golf training device of Zeiner-

Gundersen with either Jenkins or Jones” (App. Br. 13). The Examiner references *KSR* and provides specific references to Jenkins and Jones to conclude that “it would have been obvious to an artisan at a time prior to the invention to substitute one method (wind speed and direction sensor) for the other (manual entry of wind speed and direction) to achieve the predictable result of indicating a suggested golf club type” (Ans. 16). “[A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132” (*In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011)). As the Examiner has set forth specific citations to the references relied upon, and has explained why the skilled artisan would modify Zeiner-Gundersen with either Jenkins or Jones, we conclude that the Examiner has met the notice requirement of 35 U.S.C. § 132 and has provided a reason for the stated combination. Accordingly, Appellants’ contentions are not persuasive and the Examiner’s rejection of claim 8 over Zeiner-Gundersen, Mauritz, Hines and Jenkins or Jones is sustained.

Claims 9 and 11 in view of Zeiner-Gundersen, Mauritz, Hines and Jenkins or Jones

Claims 9 and 11 both depend from claim 8. Both also further require a “display” to indicate “wind speed and direction” (claim 9) or “ground condition” (claim 11). In addition to the arguments presented above with respect to claim 8, Appellants assert that the Examiner “appears to fail to address the display features of claims 9 and 11” (App. Br. 13). This is not accurate as the Examiner has indicated “that Zeiner-Gundersen teaches [a] display” as does Jenkins and Jones (citations omitted) (Ans. 16-17).

Accordingly, Appellants' contention is not persuasive and the Examiner's rejection of claims 9 and 11 over Zeiner-Gundersen, Mauritz, Hines and Jenkins or Jones is sustained.

Claims 27 and 28 in view of Zeiner-Gundersen, Mauritz, Hines and Wilens

Claims 27 and 28 each depend from claim 26. Appellants contend that these claims are allowable "by virtue of their dependencies from claim 26" (App. Br. 14). No further arguments are presented. Accordingly, as the rejection of claim 26 was sustained, we likewise sustain the rejection of claims 27 and 28.

CONCLUSION

Zeiner-Gundersen suggests a laser rangefinder and combining Zeiner-Gundersen and Hines does not render the combination unsatisfactory for its intended purpose, does not change the principle operation of Zeiner-Gundersen and is not the result of improper hindsight.

DECISION

1. The rejection of claims 23, 29 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Wilens and Hines is affirmed.
2. The rejection of claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Wilens, Hines and Mauritz is affirmed.
3. The rejection of claims 1-7, 10, 12, 26 and 30 as being unpatentable over Zeiner-Gundersen, Mauritz and Hines under 35 U.S.C. § 103(a) is affirmed.

4. The rejection of claims 8, 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Mauritz, Hines and Jenkins or Jones is affirmed.

5. The rejection of claims 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Zeiner-Gundersen, Mauritz, Hines and Wilens is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

MP